Appln No. 10/706,360

Filing Date: 11/12/2003

Attorney Docket No. 279423

Applicant(s): LISKOV, et al.

Examiner: TUAN-KHANH PHAN

Group Art Unit: 2163

Summary of The Office Action

Claims 1-2, 4-24 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The term "three-way" has been removed from the claims. Thus, claims 1-2, and 4-24 comply with 35 U.S.C. §112.

Claims 1-2, 4-24 were rejected under 35 USC 103(a) as purportedly being unpatentable over Burbeck et al. (US Pat. 7,143,139)(Burbeck), in view of Srivastava (US Pat. 7,047,315)(Srivastava).

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Response

35 U.S.C. §103

Claims 1-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Burbeck and further in view of Srivastava. To establish a prima facie case of 35 U.S.C. §103 obviousness, basic criteria must be met. The prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.(A) Section 2131 of the MPEP recites how "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). This same standard applies to 103 rejections as evidenced by Section 2143(A) of the MPEP, which reads: "The rationale to support a conclusion that the claim would have been obvious is that **all the claimed elements** were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions".

When establishing a prima facie case of obviousness the Office must clearly articulate the reason(s) the claimed invention would have been obvious. MPEP 2142 recites that:

> The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at

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___ , 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Additionally, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). This requirement is intended to prevent unacceptable "hindsight reconstruction" where Applicant's invention is recreated from references using the Application as a blueprint.

Here, the criteria for establishing a prima facie case of obviousness are not satisfied since the combination of references does not teach or suggest all the claim limitations. None of the references, alone and/or in combination, teach "providing in a router a database of bindings of client devices to network applications to replicas of a network application."

In response to Applicant's previous arguments that the combination of Burbeck and Srivastava fails to teach the claims the Office Action states:

> if a three-way binding means there exiting a mediator between two parties as shown in Figure of claimed invention, a web service that affect services between a P2P (col. 6, lines 40-47; i.e. having servlets called routers, col. 9, ll. 1-5),). Plus, a node of Burbeck equivalently has an identifier such that when reentering the network it is recognized (abstract, persistent identifier with reputation information). Thus, Applicant's argument is not persuasive. (Office Action page 3, first paragraph).

Bindings of client devices to network applications to replicas of network applications occur within a database. The Office Action's interpretation, that a web service is equivalent to a database is not reasonable. A database of bindings does not impart the meaning suggested by the Office Action.

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The MPEP requires that:

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." >The Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard:

The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1). (MPEP 2111)

The Office Action attempts to equate a web service with the database bindings. A web service "is an interface that describes a collection of network-accessible operations." (Burbeck Col. 6 lines 38-40). As provided by Burbeck a web service is an application, **not a database** with bindings relating a client device, network application, and replica network application. Burbeck teaches the use of a peer-to-peer web service to facilitate file sharing.

Web services technology is a mechanism which is known in the art for distributed application integration in client/server networks such as the World Wide Web, and enables distributed network access to software for program-to-program operation in these networks. Web Services leverage a number of open web-based standards, such as HTTP, SOAP and/or XML... (Burbeck Col. 6, lines 56-62)

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One of ordinary skill in the art would appreciate that a database binding data element is not equivalent to a web service. A web service provides application services while a database relates and stores information. Nothing in Burbeck teaches a database that relates the three elements that are claimed.

Page 4 of the Office Action states:

> providing in a router a database of three-way bindings of client devices (i.e. binding or selecting a persistent node identifier and reputation information then assigning to each network participant so that the node indentifier can be identified and connected to the associated database, col. 4, ll. 60-67) to network applications to replicas of network applications, where the session includes a session state, a three way binding includes a binding expiration time (i.e. within a configurable time interval allowed, col. 3, line 25),

The Office Action makes no citation or explanation of how the combination teaches the limitations of "to network applications to replicas of network applications." The Office Action excises these claim limitations from the explanation and cites Burbeck as teaching only "providing in a router a database of bindings of client devices."

The cited passages of Burbeck do not teach a binding for a client device in a database. Burbeck teaches a two way binding that facilitates identifying a **peer** that may move around in a peer-to-peer (P2P) network. The two way binding includes an IP address of the peer, a date, a time, and a domain. The two way binding does not include a client device identifier. "A persistent identifier is assigned to each network participant, i.e. node, such that the node can be identified after it leaves and re-enters the network." (Burbeck Col. 6, lines 61-63). The Office Action argues that this passage of Burbeck teaches a client device identifier. However, from Burbeck's

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own explanation it is clear that each peer node is represented by an IP address and a domain name. In Burbeck, there is no association between a client node and any of the other nodes. The claim requires three distinct elements bound via the database. However, each record of Burbeck contains only two elements of the required elements, a node IP address and a domain name of a peer. Nothing in Burbeck teaches binding these two elements to another address identifying the client node.

Burbeck provides a more detailed explanation of this teaching at column 12, lines 7-56. The following table provides a sentence-by-sentence analysis of this passage.

Burbeck Col. 12 lines 7-56	Teaches database in a router?	Teaches bindings of client devices to network applications to replicas of a network application?
According to preferred embodiments, transient nodes in a P2P network are identified using a linkbase identifier ("ID"), or "LBuuid", where this LBuuid has the form: [IP_Address-Date-Time-Domain]	NO	NO
and is modeled on the concepts of Universal Unique Identifiers, or "UUIDs". UUIDs are known in the art as a technique for uniquely identifying an object or entity on the public Internet. (However, the LBuuid format is not	NO	NO

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